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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,397	10/14/2004	Akihiro Nishida	UNIU79.034APC	9195

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EXAMINER	
PRITCHETT, JOSHUA L	

ART UNIT	PAPER NUMBER
2872	

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/511,397	NISHIDA ET AL.	
	Examiner	Art Unit	
	Joshua L. Pritchett	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2 and 4-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2 and 4-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 October 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is in response to Amendment filed October 10, 2006. Claims 2, 4, 5 and 7-9 have been amended and claims 1 and 3 have been cancelled as requested by the applicant.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2 and 4-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3-10 of copending Application No. 10/510,466 in view of copending application 10/029,721.

Regarding claims 2, 14 and 16, 10/510,466 claims a light-diffusing sheet comprising a light-diffusing layer, which is made of a resin coating layer having a minute unevenness formed

on a surface thereof, is formed on at least one side of a transparent film, wherein the transparent film includes a thermoplastic resin (A) having a substituted and/or non-substituted imido group in a side chain, and a thermoplastic resin (B) having a substituted and/or non-substituted phenyl group and nitrile group in a side chain (claim 1). 10/510,466 claims the invention as claimed but lacks reference to the glossiness of the surface. 10/029,721 claims wherein a 60^{0} glossiness on the surface with the minute unevenness is 70% or less (claim 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the 10/510,466 invention include the glossiness features of 10/029,721 for the purpose of controlling the reflection of light incident on the surface of the light-diffusing sheet.10/510,466 lacks the limitations regarding the spacing and roughness. 10/029,721 claims an average height-depth spacing (Sm), a center-line average surface roughness (Ra) and a ten-point average surface roughness (Rz) on the surface with the minute unevenness satisfies the respective following relations: $Sm \leq 80$ μm, $Ra \leq 0.25$ μm and $Rz \leq 9Ra$ (claim 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the 10/510,466 invention include the spacing and roughness features of 10/029,721 for the purpose of minimizing inadvertent diffusion as a result of surface irregularities to provide a more definite and precise diffusion of incident light.

Regarding claims 4 and 15, 10/510,466 claims wherein the transparent film is a biaxially stretched film (claim 7).

Regarding claim 5, 10/510,466 claims wherein the resin coating layer comprises fine particles and the surface unevenness shape of the resin coating layer is formed with the fine particles (claim 3).

Regarding claims 6 and 17, 10/510,466 claims wherein the fine particles are organic fine particles (claim 4).

Regarding claims 7 and 18, 10/510,466 claims wherein the resin coating layer is formed with ultraviolet curing resin (claim 5).

Regarding claims 8 and 19, 10/510,466 claims a low refractive index layer lower in refractive index than the resin coating layer is provided on the unevenness surface of the resin coating layer of the light-diffusing sheet (claim 8).

Regarding claims 9 and 11, 10/510,466 claims the light-diffusing sheet is provided on one side or both sides of an optical element (claim 9).

Regarding claims 10 and 12, 10/510,466 claims a display comprising the optical element (claim 10).

Regarding claim 13, 10/510,466 claims wherein if in the transparent film, a direction along which an in-plane refractive index is maximized is X axis, a direction perpendicular to X axis is Y axis, a thickness direction of the film is Z axis; refractive indexes in the respective axis directions are nx, ny and nz; and a thickness of the transparent film is d (nm) by definition, the transparent film satisfies the following relations: in-plane retardation $Re = (nx - ny) \times d \leq 20$ nm and thickness direction retardation $Rth = \{(nx + ny)/2 - nz\} \times d \leq 30$ nm (claim 6).

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuji (EP 1 160 591) in view of Suzuki (US 2002/0150722).

Regarding claims 14 and 16, Fuji teaches a light-diffusing sheet comprising a light-diffusing layer, which is made of a resin coating layer having a minute unevenness formed on a surface thereof, is formed on at least one side of a transparent film, wherein the transparent film includes a thermoplastic resin (A) having a substituted and/or non-substituted imido group in a side chain, and a thermoplastic resin (B) having a substituted and/or non-substituted phenyl group and nitrile group in a side chain (abstract). Fuji lacks reference to the spacing and roughness. Suzuki claims an average height-depth spacing (Sm), a center-line average surface roughness (Ra) and a ten-point average surface roughness (Rz) on the surface with the minute unevenness satisfies the respective following relations: $Sm \leq 80$ μm, $Ra \leq 0.25$ μm and $Rz \leq 9Ra$ (Table 3 Ex. 1). Suzuki teaches Sm = 40 microns, Ra = 0.174 microns and Rz = 1.19 microns. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Fuji invention include the spacing and roughness features of Suzuki for the purpose of minimizing inadvertent diffusion as a result of surface irregularities to provide a more definite and precise diffusion of incident light.

Regarding claim 15, Fuji teaches wherein the transparent film is a biaxially stretched film (para 0158).

Regarding claim 17, Fuji teaches wherein the fine particles are organic fine particles (para. 0127).

Regarding claim 18, Fuji teaches the invention as claimed but lacks reference to ultraviolet curing. Suzuki teaches the resin coating layer is formed with ultraviolet curing resin (para. 0085). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Fuji invention formed by ultraviolet curing as taught by Suzuki for the purpose of efficiently and precisely setting the resins used to create the light-diffusing sheet.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fuji (EP 1 160 591) in view of Suzuki (US 2002/0150722) as applied to claims ~~1 and~~ 14 above, and further in view of Winston (US 2002/0061178). 11/22/06

Fuji in combination with Suzuki teaches the invention as claimed but lacks a low index refractive layer. Winston teaches a low refractive index layer lower in refractive index than the resin coating layer is provided on the unevenness surface of the resin coating layer of the light-diffusing sheet (Figs. 2C and 2D; para. 0091). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Fuji in combination with Suzuki invention include the low refractive index layer of Winston for the purpose of substantially matching the refractive index of the light emitting layer with air to prevent reflection at the

interface of the air and the light-diffusing sheet thus emitting as much light intensity as possible and providing a brighter image to the viewer.

Allowable Subject Matter

Claims 2 and 4-13 would be allowed if the double patenting rejection were overcome, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the prior art other than the references used to provide a showing of double patenting fails to teach or suggest the light-diffusing sheet with a 60^{0} glossiness on the surface with the minute unevenness is 70% or less.

Response to Arguments

Applicant's arguments, see Amendment, filed October 10, 2006, with respect to objection to the abstract have been fully considered and are persuasive. The objection of abstract has been withdrawn. Applicant amended the abstract to comply with the standards set forth in the MPEP.

Applicant's arguments filed October 10, 2006 have been fully considered but they are not persuasive.

Applicant argues the transparent film of the present invention shows excellent adhesion which is not taught by the prior art. This limitation in not in the claims, therefore this argument is moot.

Applicant argues the excellent adhesion is unexpected. Applicant has provided no evidence of unexpected results, therefore this argument is not persuasive.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L. Pritchett whose telephone number is 571-272-2318. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua L Pritchett
Examiner
Art Unit 2872

DREW A. DUNN
SUPERVISORY PATENT EXAMINER